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In re Application of	:	
WILLIAM PLENDERLEITH	:	DECISION ON
U.S. Application No.: 09/989,351	:	PETITION
Filing Date: November 20, 2001	:	UNDER
Attorney's Docket No.: 717901.16	:	37 CFR 1.182
For: SPORTS VEHICLE	:	

This is in response to applicant's "Petition for Correction of National Phase Filing Status for a Patent Application Under 37 CFR Section 1.182" filed 14 February 2002. Applicant included the \$130 petition fee.

### BACKGROUND

On 22 May 2000, applicant filed an international application PCT/GB00/01926, which claimed priority of United Kingdom application no. 9911843.2 filed 22 May 1999.

On November 20, 2001, applicant filed a "UTILITY PATENT APPLICATION TRANSMITTAL" letter for filing of a new nonprovisional application under 37 CFR 1.53(b) in the United States, which was accompanied by, inter alia, the filing fee, a specification, drawings, claims, abstract, preliminary amendment and an executed declaration.

On January 11, 2002, the applicant's attorney contacted the USPTO to ascertain why the Notice of Acceptance (PCT/DO/EO/903) was never received by the applicant. The examiner in charge of the application informed the attorney that the application was forwarded to the Office of the PCT Legal Administration. Subsequently, a Special Programs Examiner from the PCT Legal Administration Office called the attorney and verified that the instant application was accepted as a by-pass continuation patent application and not a national phase patent application filed under 37 CFR 371.

### DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in

35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

\* \* \*

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The "UTILITY PATENT APPLICATION TRANSMITTAL" filed on November 20, 2001 indicated that the application was a filing of a new nonprovisional application under 37 CFR 1.53(b). The transmittal letter used by applicant is to be used only with submissions under 35 U.S.C. 111(a). Note that the letter has the statement "(Only for new nonprovisional applications under 37 CFR 1.53(b))". The filing under 37 CFR 1.53(b) is only directed to application filed under 35 U.S.C. 111(a). Applicant thus did not give specific instructions to enter the national stage. Therefore, the application was properly treated by OIPE as a filing under 35 U.S.C. 111(a). Even if there were other evidences to support the filing of this application as a national stage application, e.g. the preliminary amendment being addressed to Box PCT, the box for a continuing application information on the transmittal letter not being checked, etc., the transmittal letter would have been considered as conflicting instructions and the papers would have been rightfully considered as having been filed under 35 U.S.C. 111(a).

Consequently, the application is deemed to have been filed under 35 U.S.C. 111(a).

#### CONTINUATION APPLICATION

However, applicant is entitled to claim benefit under 35 U.S.C. 120 and 365© of the filing date of the international application for the common subject matter, since this application (Serial No. 09/989,351) and the international application (PCT/GB00/01926) designating the United States were copending on November 20, 2001. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is an continuation of international application PCT/GB00/01926, filed May 22, 2000, which designated the United States and is now abandoned."

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the priority document. The certified copy of priority

document submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

CONCLUSION

For the reasons stated above, the petition for correction of national phase filing status for a patent application under 37 CFR 1.182 is **DISMISSED** without prejudice.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

This application is being returned to the Technology Center 3600 for continued prosecution.



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